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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,219	12/19/2005	Conrad Thomas	8369.017.USD000	4060
77176 7590 08/19/2008 Novak, Druce & Quigg LLP 1300 I Street, N.W. Suite 1000, West Tower WASHINGTON, DC 20005				
EXAMINER AMORES, KAREN J				
ART UNIT		PAPER NUMBER		
3616				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,219

**Applicant(s)**

THOMAS ET AL.

**Examiner**

KAREN AMORES

**Art Unit**

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-29 and 32-47 is/are pending in the application.
- 4a) Of the above claim(s) 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Acknowledgment is made of Applicants' amendment to the claims filed on 11 June 2008. Claims 1 – 15 and 30 – 31 are canceled, and claims 32 – 47 are added. The replacement drawings are accepted.

### ***Claim Objections***

2. Claims 36, 38 – 44 are objected to because of the following informalities:
3. Claim 36 is dependent on itself.
4. Claims 38 and 39 are depending on canceled claim 1, and following claims 40 – 44 are depending claims.
5. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 38 – 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In order to apply art to objected claims, objected claims were assumed dependent on

the only independent claim 32 prior to the objected claims. When placed in combination, limitations such as chambers disposed on opposite or along a centerline of said body are not supported by the specification. The recitation "said body" may represent "the body of the vehicle", as first mentioned in claim 32, resulting in a new matter-rejection; or less closely by language to "said elastic body", which would result in a rejection due to indefiniteness. Similarly, claims 39, 40, and 42 recite "said body".

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 40 – 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 40 recites the limitation "said first mentioned chambers" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 45 recites the limitation "said first set of chambers" in lines 7, 8, and 13. There is insufficient antecedent basis for this limitation in the claim.
12. Claim 45 recites the limitation "said second set of chambers" in lines 10 and 11. There is insufficient antecedent basis for this limitation in the claim.
13. Claim 45 recites the limitation "said third set of chambers" in line 14. There is insufficient antecedent basis for this limitation in the claim.
14. Claim 45 recites the limitation "a first restricted orifice" three times, in lines 6, 7, 9, and 12, and recites the limitation "a second restricted orifice" three times, in lines 7, 8, 10, and 13,

which makes the claim indefinite as to whether the second and third mention of these elements are additional structures.

15. Claim 45 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationship is to which element previously recited has a valve, see lines 8, 11, and 14 stating “having a valve”.

***Claim Rejections - 35 USC § 102***

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 32 and 34 – 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugasawa, U.S. 4,749,210 (“Sugasawa”). Sugasawa discloses a system for damping vibratory forces applied to a vehicle, comprising:

18. at least one mount including a first rigid member (406) connectable to the body of a vehicle, a second rigid body connectable to a wheel suspension system of said vehicle and an elastic body interconnecting said rigid members having a pair of chambers provided with a damping liquid (fig. 10), a first restricted orifice interconnecting said chambers and a second restricted orifice intercommunicating said chambers provided with a valve (column 7, line 44);

19. means for detecting vibratory forces applied to said vehicle; and

20. processing means responsive to detected vibratory forces operatively connected to said valve for controlling the passage of said damping liquid through said second orifice and correspondingly vary the damping effect of said mount.

21. In reference to claims 34 – 37, Sugawara further discloses the detecting means is functional to detect vibratory forces applied to a front axle of said vehicle (fig. 4); at least two of said mounts and wherein said processing means is operable to selectively actuate the valve of one of said mounts corresponding to a selected vibratory force detected (column 20, line 37); wherein said detecting means is functional to detect vibration forces applied to a front axle of said vehicle (column 9, line 37), and said processing means is operable to selectively actuate the valve of at least one mount interconnecting a rear suspension system and a body of said vehicle (column 11, line 61); and wherein said mount is functional to be conditioned in combinations of low and high stiffness and low and high damping.

22. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

23. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugawara in view of Garety et al. U.S. 2005/0077662 (“Garety”). Sugawara discloses the second orifice is linear. Sugawara does not directly disclose the first orifice as arcuate. Garety teaches an orifice (30) as arcuate. It would have been obvious for a person having ordinary skill in the art at the time the invention was made to modify Sugawara such that it comprised the arcuate passage in view of the teachings of Garety so as to maximize the length of the channel, imposing damping

fluid movement to or from the upper portion into or out of the lower chamber, providing a desired dynamic stiffness, conventional in the art [0027].

24. Claims 32, 34 – 38, 40, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urababa et al. U.S. 4,897,776 (“Urababa”). Urababa discloses a system for damping vibratory forces applied to a vehicle, comprising:

25. at least one mount including a first rigid member (2) connectable to the body of a vehicle, a second rigid body connectable to a wheel suspension system of said vehicle and an elastic body interconnecting said rigid members having a pair of chambers provided with a damping fluid (column 14, line 40), a first restricted orifice interconnecting said chambers and a second restricted orifice intercommunicating said chambers provided with a valve (column 3, line 67);

26. means for detecting vibratory forces applied to said vehicle; and

27. processing means responsive to detected vibratory forces operatively connected to said valve for controlling the passage of said damping fluid through said second orifice and correspondingly vary the damping effect of said mount.

28. Urababa does not disclose the fluid to be liquid. Examiner takes official notice that it would have been obvious for a person having ordinary skill in the art at the time the invention was made to modify Urababa such that it disclosed a liquid, such as an oil, a hydraulic suspension, or a combination hydro-pneumatic system, so as to be old and well known and also interchangeable in the art.

29. In reference to claims 34 – 38, 40 and 43, as best understood and assumed dependent on claim 32, Urababa further discloses the detecting means is functional to detect vibratory forces

applied to a front axle of said vehicle (fig. 2); at least two of said mounts and wherein said processing means is operable to selectively actuate the valve of one of said mounts corresponding to a selected vibratory force detected (column 5, line 32); wherein said detecting means is functional to detect vibration forces applied to a front axle of said vehicle (column 8, line 31), and said processing means is operable to selectively actuate the valve of at least one mount interconnecting a rear suspension system and a body of said vehicle (column 10, line 51); wherein said mount is functional to be conditioned in combinations of low and high stiffness and low and high damping; and wherein said chambers of said elastic body are disposed on opposite sides of a centerline of said body (fig. 3); wherein said first mentioned chambers of said elastic body are disposed on opposite sides of a centerline (Lf) of said body, and including a second pair of chambers (4) of said elastic body spaced along said centerline of said body provided with a damping fluid, a first restricted orifice interconnecting said second pair of chambers and a second restricted orifice intercommunicating said chambers provided with a valve (column 3, line 67); and wherein said processing means is operative to selectively actuate said valves in response to selected vibrating forces detected.

30. Claim 39, as best understood and assumed dependent on claim 32, is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugasawa in view of Spivey et al. U.S. 6,418,360 ("Spivey"). Sugasawa does not disclose the chambers to be disposed along a centerline of the body. Spivey teaches chambers to be disposed along a centerline of a body (fig. 1). It would have been obvious for a person having ordinary skill in the art at the time the invention was made to modify Sugasawa such that it comprised the chambers disposed along a centerline in



view of the teachings of Spivey so as to provide a controlled suspension for a vehicle such as a motorcycle (fig. 1).

*Allowable Subject Matter*

31. Claims 45 – 47 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAREN AMORES whose telephone number is (571)272-6212. The examiner can normally be reached on Monday through Friday, 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571)-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul N. Dickson/  
Acting SPE of Art Unit 3616

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Examiner  
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